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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/866,593	05/30/2001	John J. Ryan III	274	4947

7590 07/01/2004  
KRIEG DEVAULTLUNDY, LLP  
825 Anthony Wayne Building  
203 E. Berry Street  
Fort Wayne, IN 46802

EXAMINER

MORRISON, NASCHICA SANDERS

ART UNIT PAPER NUMBER

3632

DATE MAILED: 07/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary**

Application No.

09/866,593

Applicant(s)

RYAN ET AL.

Examiner

Naschica S Morrison

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 February 2004 and 05 April 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2,3,5-9,11-16,18-20 and 24-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2,3,5-9,11-16,18-20 and 24-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 5/30/01 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 13 February 2004 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

This is the fourth Office Action for serial number 09/866,593, Insulating Wire Separator Apparatus for Piping Systems, filed on May 30, 2001. Claims 2, 3, 5-9, 11-16, 18-20, 24-29 are pending.

#### ***Information Disclosure Statement***

The information disclosure statement filed 4/5/04 fails to comply with 37 CFR 1.98(a)(1), which requires a list of all patents, publications, or other information submitted for consideration by the Office. It has been placed in the application file, but the information referred to therein has not been considered.

#### ***Response to Amendment***

The amendment filed 3/20/03 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: “*about* sixty degrees” and “*about* eighty degrees” on lines 5-6 of the paragraph starting on page 21, line 7; “foot plate and earth anchor portion” on line 3 of the paragraph starting on page 21, line 14 (see also repetitive occurrences throughout the specification); “*about* three inches” and “*about* six inches” on line 7 of the paragraph starting on page 21, line 18 (see also repetitive occurrences in the specification).

Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Drawings***

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they *do not include* the following reference sign(s) mentioned in the description: 122 on page 7, line 7. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 2, 3, 5-9, 11-16, 18-20, and 24-29 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Regarding claims 7 and 28, the limitation “*about* sixty to *about* eighty degrees” is not found in the original specification and is not supported thereby. Regarding claim 11, the limitation “at *about* least two inches” is not found in the original specification and is not supported thereby. Regarding claim 8, the limitation “*about* three to *about* thirty degrees” is not found in the original specification and is not supported thereby. Regarding claim 24, the limitation “a foot plate and earth anchor portion” in line 15 is not found in the original specification or supported thereby.

***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 2, 6, 24, 26 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,601,260 to Shinohara et al. (Shinohara). With regards to claims 2, 6, 24, 26, 27, Shinohara discloses a wire support (Fig. 2) made of resin comprising: an elongated body (10 generally) having opposite ends, a resilient main conduit receiving portion (41 adjacent 14) at one end of the body having an inner radius sized to receive a conduit and a pair of conduit engaging sliding wedge surfaces (surfaces of 50 and 52 defining the opening/gap therebetween) on opposite sides of an opening (between 50 and 54A); an I-beam arm portion (extending between 20 and 14) extending away from the main conduit receiving portion (41 adjacent 14) on the side opposite the opening (between 50 and 54A) and extending to the opposite end of the elongated body a distance beyond the main conduit receiving portion; a plate and anchor portion (46 located between 41 and 52) extending generally perpendicularly from the arm portion in proximity to the conduit receiving portion (41 adjacent 14); a wire clip portion (41 adjacent 12) having a pair of fingers (50,52) and positioned adjacent to the opposite end of the elongated body; and a separator post (30,40) extending generally perpendicular from the arm portion and spaced from the plate portion but in proximity to the wire clip portion, the arm portion extending beyond the separator post (30,40).

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 3, 5, 7, 8, 11, 19, 20, 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shinohara. Regarding claims 3 and 11, arguably Shinohara teaches the arm portion extending at least two inches beyond the separator post (30). Additionally, Shinohara does not explicitly teach the separator post spaced at least ten inches from the plate portion. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the arm portion and separator post to extend the specified distances since it has been held that a change in the size of a prior art device is a design consideration within the skill of the art. In re Rose, 220 F.2d 459, 105 USPQ 237 (CCPA 1955).

Regarding claims 5 and 20, Shinohara does not disclose the wire support being color-coded. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the wire support to be any of various colors because one would have been motivated to provide a device that is aesthetically pleasing as is well known in the art.

Regarding claims 7, 8, 19, 28 and 29, Shinohara discloses the wire support as applied to claims 2, 6, 24, 26 and 27 above, but does not teach the opening (between 50 and 54A) being angled from about sixty to about eighty degrees from the centerline of a conduit or the wire clip finger portion (41 adjacent 12) being angled from about three to about thirty degrees from the centerline of the arm portion (20). However, it

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would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the opening of the main conduit receiving portion to be angled between about sixty and about eighty degrees or the wire clip finger portion to be angled between about three and about thirty degrees since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

Claims 9 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shinohara in view of U.S. Patent 5,772,166 to Adams. With regards to claims 9 and 18, Shinohara discloses the wire support as applied above, but does not teach the main conduit receiving portion comprising first and second half radiused portions. Adams discloses a mounting clip comprising a main conduit receiving portion (Fig. 11) including a first half radiused portion (132) releasably fastened to a second half radiused portion (134) by a releasable fastener (140,142). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the main conduit receiving portion to include first and second half radiused portions releasably fastened together because one would have been motivated to provide a means for adjusting the position of the item secured therein as taught by Adams (col. 8, lines 13-20).

Claims 12-15 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shinohara in view of U.S. Patent 5,018,260 to Ziu. With regards to claims 12-15 and 25, Shinohara discloses the wire support to claims 2, 3, 5-8, 11, 24, 26, and 27 as applied above, but does not disclose the main conduit receiving portion including a strengthening rib. Ziu discloses a wire clip comprising a main conduit receiving portion

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(18) including an outwardly extending rib (40) extending thereabout. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the wire support of Shinohara by including an outer rib extending between the conduit engaging surfaces and arm portion (i.e. the entire length of the conduit receiving portion) because one would have been motivated to provide a stronger gripping support as taught by Ziu (col. 5, lines 56-58).

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shinohara in view of Ziu and further in view of U.S. Patent 5,772,166 to Adams. With regards to claim 16, Shinohara in view of Ziu discloses the wire support as applied to claims 12-15 and 25 above, but does not teach the main conduit receiving portion comprising first and second half radiused portions. Adams discloses a mounting clip comprising a main conduit receiving portion (Fig. 11) including a first half radiused portion (132) releasably fastened to a second half radiused portion (134) by a releasable fastener (140,142). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the main conduit receiving portion to include first and second half radiused portions releasably fastened together because one would have been motivated to provide a means for adjusting the position of the item secured therein as taught by Adams (col. 8, lines 13-20).

### ***Response to Arguments***

Applicant's arguments filed 2/12/04 have been fully considered but they are not persuasive.



Applicant's arguments regarding the 112/1<sup>st</sup> paragraph rejection of claims 2, 3, 5-9, 11-16, 18-20, and 24-29 are not persuasive. Specifically, examiner does not agree that the range specified by the words "about sixty degrees" is inherently included or inferred by the words "sixty degrees". Additionally, it is still unclear as to how the addition of the word "foot" before "plate" in the term "a foot plate and earth anchor portion" is supported by the specification and drawings.

In response to applicant's argument that the conduit receiving portion (identified as member 41 adjacent to numeral 14 in Fig. 2) is not at one end of the retainer, examiner respectfully disagrees since the end is generally considered to include the portion indicated by 41 adjacent to 14 and the portion indicated by 14. In response to applicant's argument that the tracer wire clip portion of Shinohara is not "at the opposite end of the retainer", it is noted that the feature upon which applicant relies (i.e., at the opposite end of the retainer) is not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In response to applicant's argument that Shinohara has nothing to do with positioning a tracer wire from a conduit, etc., a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a

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manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

In response to applicant's argument that Shinohara does not include an anchor portion, examiner respectfully disagrees since plate 46 performs the function of applicant's anchor portion as claimed (i.e. prevents rotation (about a vertical axis) about a conduit). Regarding Shinohara's wire clip portion, examiner has also disclosed that the wire clip portion (41 adjacent 12) is a different structure than the conduit receiving portion (41 adjacent 14). Additionally, examiner respectfully disagrees that Applicant's separator post is totally distinguished from Shinohara's separator post since the separator post of Shinohara reads on the claimed limitations as cited in the rejection above.

In response to applicant's argument that only one of the sliding wedge surfaces of Shinohara functions as claimed, examiner respectfully disagrees since the claims only recite that the main conduit receiving portion is flexed so as to expand. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., separator post positioned between said other end...and said foot plate and earth anchor portion, a tracer wire clip midway between said separator post and the center line of said main conduit portion) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument that there is no reason to modify the distance between the plate and separator post of Shinohara because there is no purpose for the separator post of Shinohara, examiner respectfully disagrees since the separator post is clearly used to mount the retainer as shown in Fig. 3. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the suggestion and motivation to combine the references is found in the references themselves and/or in the knowledge generally available to one of ordinary skill in the art as cited in the rejections above.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).


***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Naschica S. Morrison, whose telephone number is (703) 305-0228. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Leslie Braun can be reached at 703-308-2156. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this Application should be directed to the Technology Center receptionist at (703) 306-1113.

  
Naschica S. Morrison  
Patent Examiner  
Art Unit 3632  
6/28/04

  
ANITA KING  
PRIMARY EXAMINER